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10/674,778	09/30/2003	Jerry Waikit Tsui	CA920020061US1	4447

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PATENTS ON DEMAND, P.A.
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EXAMINER

RANKINS, WILLIAM E

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3696

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,778	Applicant(s) TSUI ET AL.	
	Examiner WILLIAM E. RANKINS	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/30/2003 and 02/14/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 09/30/2003 and 02/14/2008 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

Claims 1-20 are pending in this application. Claims 1, 6, 11, 16 and 17 g=have been amended. Claims 18-20 are new.

Response to Arguments

1. Applicant's arguments, see pg. 10, filed 02/26/2008, with respect to claim 1 have been fully considered and are persuasive. The 101 rejection of 11/26/2007 has been withdrawn.
2. Applicant's arguments, see pg. 10, filed 02/26/2008, with respect to claim 17 have been fully considered and are persuasive. The objection of 11/26/2007 has been withdrawn.
3. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

1. Applicant is advised that should claims 1-5 and 18 be found allowable, claims 6-10, 19 and 11-15 and 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

2. Claims 17-20 are objected to because of the following informalities: the word functionality is misspelled as functionally. Appropriate correction is required.

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3696

1. Claims 11-15 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11-15 and 20 are directed toward a program (web service interface), which is not embodied on a computer readable medium and is therefore not statutory, See MPEP 2106.01.

2. Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the present case, 'the use of' a billing service is not a statutory class of invention. See MPEP 2106, section IV..

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The term "well-defined" in claims 17-20 is a relative term which renders the claim indefinite. The term "well-defined" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

b. The term "self-contained" in claims 17-20 is a relative term which renders the claim indefinite. The term "self-contained" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

c. The term "specific functionally" in claims 17-20 is a relative term which renders the claim indefinite. The term "specific functionally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

4. Claims 2, 7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the present case the term 'second billing functions' is not defined by the disclosure. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Robohm et al. (2002/0138828).

As per claim 1:

Robohm discloses:

A software system digitally encoded in at least one machine readable medium configured to usable by at least one machine for use in providing a web service interface for a billing service, wherein a plurality of first billing functions is provided by said billing service to computing applications residing on one or more computing devices in a distributed network, the software system comprising (Para. 0008 and 0057):

- a. a web service interface defined for a billing service, said web service interface being adapted for coupling to a billing engine, said billing engine residing on a computing device in said distributed network and being adapted to perform said plurality of first billing functions, said web service interface comprises a plurality of application programming interfaces, each of said application programming interfaces being associated with a first billing function and being implemented such that the first billing

Art Unit: 3696

function associated therewith is performed after a web service invocation that commands performance of said first billing function is received by said web service interface (Para's. 0008, 0034 and 0035, Figs. 3, 13, 14 and 20-27); and

b. a plurality of object classes, each of said object classes defining objects for storing data utilized by said billing engine and for communicating said data to said billing engine through at least one implemented application programming interface of said web service interface, said web service interface being used to provide said billing service as a web service that is configured to be invoked by said computing applications in said distributed network (Fig. 13).

As per claim 2;

Robohm et al. discloses:

The software system as claimed in claim 1, wherein said web service interface is extendable to provide said computing application with a plurality of second billing functions, and said billing engine is adapted to perform said second billing functions (Para. 0044).

Claims 3-5 are similarly rejected by the recitation provided for claim 2.

Claims 6-16 are similarly rejected by the recitation provided for claim 1-5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robohm et al. (2002/0138828) in view of How to get started with server-side java (Jason Hunter, Java World.com, 03/01/97 and Tsui et al. (2004/0066411).

As per claim 17;

Robohm does not disclose:

The use of a billing service, as claimed in claim 16, wherein the first billing functions of said billing service are performed by a server-side billing engine, and wherein the Web service interface is a client side interface, wherein the Web service is a well-defined, self-contained component that encapsulates specific functionality, which is made available to other computing applications over a network by web service invocation using a Simple Object Access Protocol (SOAP).

However, Hunter discloses:

Server side Java as platform independent and object oriented (pg. 1).

Art Unit: 3696

Tsui discloses:

A known solution for integrating heterogeneous internet based applications or services...the concept 'web service' (Para. 0005).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Robohm, Hunter and Tsui. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to reduce start up delays and maintain state between executions. Additionally, Tsui admits that web service is old and well known.

Claims 18-20 are rejected under the same rationale used to reject claim 17.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/
Examiner, Art Unit 3696
08/08/2008

/Daniel S Felten/
Primary Examiner, Art Unit 3696